

REMARKS

Claims 1-16 were pending in the present application. Claims 1 and 2 have been amended. Claims 17-19 have been added. No claims have been cancelled. Therefore, claims 1-19 are pending in the application. Support for the claim amendments can be found in the specification, *inter alia*, at page 9, lines 22-25 and the original claims. Accordingly, Applicants respectfully submit that no new matter has been added.

Based on the above amendments and following remarks, applicants respectfully request reconsideration of all outstanding rejections.

Information Disclosure Statement

Applicants respectfully request that the Examiner consider the reference listed on the Information Disclosure Statement submitted in a separate paper along with this response prior to the allowance of any claims.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

In the Office Action, claims 1-16 were rejected under 35 U.S.C. § 112, first paragraph for the reasons set forth in the objection to the specification. Applicants have amended the specification as seen above. Specifically, the objectionable language has been stricken from the specification. As such, it is not necessary to obtain an affidavit or declaration. Accordingly, Applicants respectfully request reconsideration of these rejections in light of the above amendment.

Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Sargeant et al. (USP 6,146,770). In response, Applicants have amended claim 1 to include the term “consisting essentially of” in order to clarify that the present invention is directed towards a film sheet comprising cellulose ether and any other material that does not materially affect

the basic and novel characteristics of the claimed invention. (see MPEP § 2111.03) As noted above and repeated here, support for this amendment can be found on page 9, lines 22-25 of the specification.

The Sargeant reference discloses an ink jet recording medium having an ink absorbent layer provided upon a substrate, with a humidity barrier layer provided upon the ink absorbent layer. The humidity barrier layer *may* contain a cellulose ether derivative (col. 2, lines 36-37).

On the other hand, according to the present invention, a film sheet for use in overhead projectors is formed of a cellulose ether (see specification page 3, lines 10-11). It can be directly printed with a jet printing ink without the intervention of a layer receptive to the jet printing ink is provided (see specification, page 3, lines 2-3 and lines 15-17, and page 4, lines 14-16). With this in mind, the Applicants have amended claim 1 as seen above to clarify the present invention.

The Office Action states that "Sargeant discloses an ink jet recording medium comprising a substrate, an ink absorbent layer onto the substrate, and a barrier layer onto the ink absorbent layer, wherein the barrier layer comprises cellulose ether derivative (col. 2, lines 26-37)." Assuming *arguendo* that "the barrier layer is equivalent to the claimed cellulose ether film," nowhere in Sargeant is there a disclosure of the barrier layer "consisting essentially of a cellulose ether." Every mention of a cellulose ether is in reference to a barrier that contains cellulose ether and other materials. This is not surprising, as the cellulose ether is merely an after ingredient in Sargeant. Indeed, the only disclosure in the description of Sargeant concerning a cellulose ether is qualified by the statement "if a cellulose ether derivative is used in the barrier layer, the amount used should be no greater than about 50% by weight." (column 3, lines 39-42) That is, the barrier of Sargeant does not, and is not intended to, consist essentially of cellulose ether. This is further evidenced by the working examples, which are completely devoid of a teaching of cellulose ether. Finally, even if the barrier layer of Sargeant did consist essentially of cellulose ether, it is noted that the disclosure of Sargeant is directed toward a medium that comprises a barrier layer *and a substrate*, and that Sargeant is silent in regard to a teaching that the substrate even comprises cellulose ether.

In view of the above facts, Applicants rely on MPEP § 2131, which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the . . . claim.” (citations omitted) It is respectfully submitted that since, as noted above, Sargeant does not teach a “film sheet for use with overhead projectors consisting essentially of a cellulose ether,” claim 1 is allowable. Claim 2, which depends from claim 1, is allowable for at least the reason that claim 1 is allowable, and for the additional reason that film sheet of claim 2 allows it to be directly printed to with a jet printing ink without the intervention of a layer receptive to the jet printing ink, as opposed to Sargeant, which relies on the substrate for a layer receptive to the ink. (see specification, page 3, lines 2-3 and lines 15-17, and page 4, lines 14-16).

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 1-16 were rejected under 35 U.S.C. §103 as being unpatentable over Sargeant et al. (USP 6,146,770) in view of Shaw-Klein et al. (USP 6,361,853) and web site posted by Shin-Etsu Chemical Co., Ltd. Applicants respectfully traverse these rejections for the reasons discussed above, and for the following additional reasons.

In traversing the rejections, Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria set out in MPEP § 2143 have not been met in the Office Action.

The References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 had been satisfied (which it has not, as seen below), the cited references still would not meet the third requirement, which is that “the

prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As explained above, Sargeant does not teach the limitations of claim 1. In the interest of brevity, the shortcomings of Sargeant will not be repeated here, but instead incorporated by reference. Shaw-Klein is likewise devoid of a teaching of a film used with overhead projectors “consisting essentially of a cellulose ether,” and the same reasons why Sargeant does not teach the limitations of claim 1 are just as applicable against Shaw-Klein.

The Office Action states that “Shaw-Klein teaches ink jet recording elements comprising a support, absorbing layer, adhesion promoting layer, and overcoat layer in the order recited. The overcoat layer comprises methyl cellulose, hydroxypropylmethyl cellulose, hydroxypropyl cellulose or sodium carboxymethyl cellulose.” Assuming *arguendo* that the overcoat layer is equivalent to the claimed cellulose ether film, it is noted that the disclosure of Shaw-Klein is directed toward a medium that comprises an overcoat layer, an absorbing layer, and an adhesion layer, and that Shaw-Klein is silent in regard to a teaching that the adhesion layer even comprises cellulose ether. The combination of Sargeant and Shaw-Klein do not attain a film sheet usable on an overhead projector unless a separate layer receptive to ink is added, a layer that is not present in Applicants’ invention. Shaw-Klein simply fails to disclose, teach, or suggest a film sheet for use with overhead projectors consisting essentially of a cellulose ether, and combining Shaw-Klein with Sargeant does nothing to rectify the deficiencies of either reference.

Lack of Suggestion or Motivation to Modify or Combine the References

The Office Action fails to identify where the prior art suggests the desirability of the claimed invention. MPEP § 2143.01, entitled *Suggestion or Motivation to Modify the References*, states that the “prior art *must* suggest the desirability of the claimed invention” (emphasis added; citations omitted). It further states that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. The level of skill in the art cannot be relied upon to provide the suggestion to combine references.” (citations omitted)

The rationale stated in the Office Action for combining the references is that Sargeant and Shaw-Klein are from the same field of endeavor (ink jet receiving art). This does not

comport with any of the three sources of "motivation" under U.S. patent law. Thus, the first requirement of MPEP § 2143.01 is not met in the Office Action, and, therefore, a *prima facie* case of obviousness has not been established.

* * * * *

Since the Office Action has not established a proper motivation to combine the cited references, and neither Sargeant nor Shaw-Klein disclose, teach, or suggest all the claim limitations of claim 1, the first and third requirements of MPEP § 2143.01 are not met, and the claim is allowable. Claims 2 through 16, which depend from claim 1, are likewise allowable.

Removal of the Shin-Etsu Chemical Co., Ltd. Web Site Reference

The Office Action relies on the website posted by Shin-Etsu Chemical Co., Ltd. to form the basis of an obviousness rejection against claims 3 and 4. It is respectfully noted that the web site print-out provided with the Office Action does not satisfy the requirements that must be met under 35 U.S.C. §102 to classify a reference as prior art. There is no evidence that this web site existed prior to the priority date of Applicants' invention, January 2000. The copyright notice at the bottom of each page suggests that the web site was "published" only at some point in the year 2001 (assuming *arguendo* that the web site meets the definition of a publication under §102). Indeed, there is not evidence that the web site even existed prior to the U.S. filing date of the application. Simply because a web site contains a copyright notice dated 2001 does not mean that the information was "published" on January 1, 2001. It could have been published on December 31, 2001. Further, the copyright notice does not even provide sufficient evidence that the information was "published" prior to 9:14 a.m. on June 02, 2002, (the print-out date of the web site) as the notice could have been added at any prior time.

Since Shin cannot be used as a reference, claims 3 and 4 and the claims that depend from either claim 3 or 4 (claims 7, 8, 11, 12, 15 and 16) are allowable for at least the reason that claims 3 and 4 are allowable, in addition to the reasons discussed above.

New Claims

Applicants have added new claims 16-19. Claim 16 is directed towards a commercial embodiment of the present invention, and is allowable for at least the reason that it is more limited than claim 1, which is allowable as seen above. Claims 17 and 18 depend from claim 16, and are likewise allowable.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

If Applicants have not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to our Deposit Account No. 19-0741. If Applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.

Examiner Shewareged is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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By



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Version with Markings to Show Changes Made (Specification)

On page 10, please replace the second full paragraph with the following:

A 3 wt% aqueous solution of hydroxypropyl methylcellulose (60SH-50; manufactured by Shin-Etsu Chemical Co. Ltd.) containing 29% by weight of the methoxyl group and 9% by weight of the hydroxypropoxyl group and having a viscosity of 50 mPa's as measured by a 2 wt% solution at 20°C was prepared. This hydroxypropyl methylcellulose is characterized in that the powder remaining on a ~~No. 1000~~ sieve having an opening of 150 μm ~~as prescribed by JIS Z8801~~ is 10% by weight when measured under the above-described conditions, and in that the number of undissolved fibers present in a 0.1 wt% aqueous solution is 600 when counted with a Coulter counter is described previously. 27 g of this solution was poured into a 30 cm x 22 cm mold made of glass, and dried at 70°C for 10 hours to form a film. The resulting 10 μm thick film was stripped from the mold.

Version with Markings to Show Changes Made (Claims)

1. (Amended) A film sheet for use with overhead projectors ~~which comprises~~
consisting essentially of a cellulose ether.

2. (Amended) A film sheet for use with overhead projectors as claimed in
claim 1, wherein an ink-jet printer ~~is~~ can be used to directly print at least one of characters
and/or pictures thereon.